



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/556,914	11/15/2005	Kaoruko Urai	URAI5	1605
1444 7590 05/04/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
SIMMONS, CHRIS E				
ART UNIT		PAPER NUMBER		
1612				
MAIL DATE		DELIVERY MODE		
05/04/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/556,914

**Applicant(s)**

URAI ET AL.

**Examiner**

CHRIS E. SIMMONS

**Art Unit**

1612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 5, 6, 8-13 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 8-13 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5 and 6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/06)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' arguments, filed 1/22/2010, have been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Election/Restrictions***

Applicant continues to argue that the specie election requirement is not proper because it is inconsistent with the requirements outlined in 806.04(f). Applicant's arguments are not deemed to have been found persuasive because the election requirement is based on requirements under Unity of Invention, which is not limited under the section cited by applicant. Accordingly, the election requirement is deemed proper pursuant to rules outlined for filings under 371(c).

#### ***Claim Rejections - 35 USC § 103***

Claims 1, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 2002/0119105 in view of US 5,213,615.

Applicant argues that the rejection does not apply to amended claim 1 because rosin is only listed in the primary reference as an example of the resin used as a dispersant of mica titanium and contends that there is no suggestion to use rosin in combination with shellac. These arguments are not found to be persuasive. The examiner maintains the position that the both references individually suggestion the

combination. The primary reference does not only teach the use of rosin separate in a composition from shellac as a dispersant for the mica titanium as alleged by applicant. It also suggest by adding such material, an improved luster of the coat is obtained. As support for examiner's interpretation [0013] and [0014] are cited below:

[0013] *"In addition to shellac as the coat-forming component, one kind or a combination of two or more kinds of other resins, high molecular materials, and dental cements can be added to the composition at a suitable amount. By adding such material(s), the preferred effects of more improving the luster of the coat and more improving the dispersion of mica titanium or pigments can be expected."*

[0014] *"Examples of such a resin include an acrylic resin, a vinyl acetate resin, an alkyd resin, a vinyl chloride resin, a silicone resin, a fluorine resin, rosin, etc." Emphasis added.*

Contrary to applicant's allegation, here the reference suggests that a resin such as rosin may be added to the composition in suitable amounts in addition to shellac in order to impart an improved luster or improved dispersibility of the mica titanium.

Applicant contends that the most effective concentrations are not claimed and the references alone or in combination fail to teach or suggest these amounts. Applicant notes that "a parameter or variable must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the parameter or variable might be characterized as routine or obvious". Applicant further contends that there is no such recognition or suggestion of the significance of rosin in the reference and, therefore, submit that it would not have been a matter of routine optimization to arrive at the claims. These contentions are not found to be persuasive. Firstly, the significance of rosin is outlined in passages in the primary reference at [0013] and [0014] cited above. Contrary to applicant's contention that the references do

not suggest any significance for rosin, it is suggested that the presence of rosin provide improved luster and improved pigment dispersibility. Regarding the relative amount of rosin recited in applicants' claims, the amount of a specific ingredient in a composition is clearly a result effective parameter that a person of ordinary skill in the art would routinely optimize. Optimization of parameters is a routine practice that would be obvious for a person of ordinary skill in the art to employ. It would have been customary for an artisan of ordinary skill to determine the optimal amount of each ingredient needed to achieve the desired results. Thus, absent some demonstration of unexpected results from the claimed parameters, the optimization of ingredient amounts would have been obvious at the time of applicant's invention.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRIS E. SIMMONS whose telephone number is (571)272-9065. The examiner can normally be reached on Monday - Friday from 7:30 - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frederick Krass can be reached on (571) 272-0580. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chris E Simmons/

Application/Control Number: 10/556,914

Page 6

Art Unit: 1612

Examiner, Art Unit 1612

/Frederick Krass/

Supervisory Patent Examiner, Art Unit 1612